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HENKEL CORPORATION THE TRIAD, SUITE 200 2200 RENAISSANCE BLVD. GULPH MILLS, PA 19406			ROSSI, JESSICA	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/877,372

Applicant(s)

SCHOLZ, KONRAD

Examiner

Jessica L. Rossi

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/13/05, RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

RCE

1. The request filed on 10/13/05 for a RCE under 37 CFR 1.114 based on parent Application No. 09/877,372 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. This action is in response to the amendment dated 7/1/05. Claims 1-4 and 13 were cancelled. Claims 5-12 and 14-18 are pending.

3. The rejection of claims 10-12 and 14-15 under 35 USC 102(b) as being anticipated by Duewel (US 4222812, of record), as set forth in paragraph 11 of the previous action, has been withdrawn in light of the limitations added to claims 10 and 14.

4. The rejection of claims 5 and 16 under 35 USC 103(a) as being unpatentable over Mathis (US 4658721, of record), as set forth in paragraph 19 of the previous action, has been withdrawn because Mathis teaches moving the embossing die/pressure element into contact with a stationary workpiece/board element and one reading the reference as a whole would readily appreciate that the reference teaches away from moving both the embossing die and workpiece to contact each other and/or moving the workpiece into contact with a stationary embossing die.

Election/Restrictions

5. The “film” and “profile bar” are still withdrawn as being directed to the non-elected species set forth in the office action dated 7/14/04.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claim 14 stands rejected under 35 U.S.C. 102(b) as being anticipated by Mathis (US 4658721, of record), as set forth in paragraph 13 of the previous office action.

With respect to claim 14, Mathis is directed to a method for uniformly adhering an embossing foil 5 (= bandlike covering) onto a narrow face of a workpiece 1 (= board element, which can be wood, cardboard; column 1, lines 19-28; column 7, lines 5-8). The reference teaches providing a embossing die 8 (= pressure element) that includes an elastically deformable pressure face that is capable of deformably matching and exerting uniform pressure on the narrow face (column 3, lines 47-52; column 4, lines 2-8), independent of a shape of the narrow face (narrow face can be flat, round, convex, concave, oval, etc. - column 1, lines 15-18; column 4, lines 4-8; Figures 1-6). The reference teaches moving the embossing die, while uniformly pressing the embossing foil onto the narrow face with the embossing die, along the length of the workpiece, thereby uniformly adhering the embossing foil onto the narrow face of the workpiece (Figures 3-4; column 3, lines 47-52; column 4, lines 2-4; column 6, lines 11-28; column 8, lines 35-51).

8. Claims 16-17 stand rejected under 35 U.S.C. 102(b) as being anticipated by LaMers (US 4547252, of record).

With respect to claim 16, LaMers is directed to a method for gluing a label 14 (= covering) onto a workpiece 272 with an adhesive, wherein the workpiece has a cross sectional surface (Figure 27; column 2, lines 48-57; column 10, lines 10-11). The reference teaches the

Art Unit: 1733

covering being pressed onto the workpiece by means of a pressure element 270 (= bellows) having an elastically deformable pressure face that deformably matches and exerts uniform pressure on the cross sectional surface independent of the profile of the cross sectional surface (Figures 7 and 27; column 4, line 63 – column 5, line 4; column 3, lines 55-63; column 10, lines 10-11). The reference teaches moving the workpiece along its length, in relation to the pressure element, while the covering is uniformly pressed onto the cross sectional surface (last sentence of abstract; column 3, lines 60-63; column 10, lines 43-48).

Regarding claim 17, the skilled artisan would have appreciated that the label of LaMers is “bandlike.”

9. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Curran et al. (US Re 23,572).

With respect to claim 14, Curran is directed to a method for uniformly adhering a bandlike covering 4 onto a narrow face of a board element 1 by providing a pressure element 6 that includes an elastically deformable pressure face that is capable of deformably matching and exerting uniform pressure on the narrow face, independent of a shape of the narrow face (Figures 1-2 and 8; column 1, lines 3-7 and 35-38; column 3, lines 5-10 and 36-37; column 4, lines 13-20 and 32-56). The reference teaches moving the pressure element, while uniformly pressing the bandlike covering onto the narrow face with the pressure element, along the length of the board element, thereby uniformly adhering the bandlike covering onto the narrow face of the board element (column 3, lines 55-61; column 4, lines 4-7 and 13-20).

10. Claims 10-12 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Manusch (US 4997512).

Art Unit: 1733

With respect to claim 10, Manusch is directed to a method for uniformly adhering a bandlike covering 7 onto a narrow face of a board element 8 by providing a pressure element that includes an elastically deformable pressure face 5 that is capable of deformably matching and exerting uniform pressure on the narrow face, independent of a shape of the narrow face (abstract; Figure 4; column 1, lines 12-18; column 2, lines 25-29 and 54-56; column 3, lines 7-11; column 7, line 5 and 11-13 and 19-20; column 8, lines 10-20). The reference teaches uniformly adhering the covering and an adhesive onto the narrow face with the pressure element (column 1, lines 15-18; column 7, lines 1-5).

Regarding claim 11, the reference teaches moving the pressure element during the pressing step (Figure 1).

Regarding claim 12, the reference teaches such (Figures 1 and 4).

Regarding claim 14, all the limitations were addressed above with respect to claim 10, except the movement being along the length of the board element – the reference teaches such (Figure 1).

Regarding claim 15, this limitation was addressed above with respect to claim 12.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 10-12 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mathis as applied to claim 14 above and as set forth in paragraph 19 of the previous action.

With respect to claim 15, Mathis is not limited to a particular shaped workpiece, or a particular size for the workpiece, or the embossing foil covering the entire narrow face of the

Art Unit: 1733

workpiece. Therefore, the skilled artisan would have readily appreciated it being obvious to apply an embossing foil onto a workpiece being of a size such that the embossing die has a length that is less than that of the narrow face of the workpiece because it is well known and conventional to apply printed embossing foils, such as labels, that do not cover the entire surface to which they are applied.

With respect to claim 10, all the limitations were addressed above with respect to claims 14-15; it being noted that claim 10 does not **require any** movement of the pressure element and/or workpiece.

Regarding claim 11, all the limitations were addressed above with respect to claim 14.

Regarding claim 12, for the same reasons as set forth above with respect to claim 15, it would have been obvious to apply the embossing foil to a workpiece of a size such that the length of the embossing die is substantially less than that of the narrow face.

13. Claim 17 stands rejected under 35 U.S.C. 103(a) as being unpatentable over LaMers as applied to claim 16 above and further in view of Hodgson (US 4132583, of record).

Regarding claim 17, it is noted that the examiner took the label of LaMers to be bandlike. If this is were not the case, the examiner would like to point out that the reference teaches the apparatus permitting the use of a wide variety of labels including very thin and flexible labels (column 10, lines 26-27). The skilled artisan reading LaMers as a whole would have appreciated that the reference is not concerned with the shape of the label nor the shape of the workpiece and therefore would have been motivated to use a label that is bandlike because it is known in the art to apply bandlike labels L to articles having a variety of shapes, including flat and rounded, using a bellows 52 which deformably matches and exerts uniform pressure on the surface of the article

Art Unit: 1733

independent of its shape, as taught by Hodgson (Figures 3 and 5; column 1, lines 66-68; column 2, lines 61-66; column 3, lines 67-68; column 4, lines 53-60; column 5, lines 31-50; column 9, lines 23-25; column 10, lines 3-7).

14. Claims 18, 5, 8-12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaMers and Hodgson as applied to claim 17 above and further in view of Treat (US 4726865, of record), as set forth in paragraph 16 of the previous action.

Regarding claim 18, LaMers is silent as to what the workpiece is and therefore is silent as to it being a board element. Hodgson teaches the workpiece can be flat, including those having a square or rectangular cross section (column 1, lines 66-68; column 10, lines 3-7), wherein the skilled artisan would have appreciated a flat workpiece having a square or rectangular cross section reading on Applicant's board element. Furthermore, it is known in the art to apply labels to circuit board components, as taught by Treat (column 1, lines 55-60), wherein the skilled artisan would have appreciated such board components reading on Applicant's board element.

Since LaMers is not concerned with a particular workpiece it would have been obvious to the skilled artisan to apply the label of LaMers to a board element because such is known in the labeling art, as taught by the collective teachings of Hodgson and Treat, where only the expected results would have been achieved.

With respect to claim 5, all the limitations were addressed above with respect to claims 16-18.

Regarding claim 8, LaMers teaches the bellows being an elastic band (Figure 27; column 4, lines 63-66).

Art Unit: 1733

Regarding claim 9, selection of a particular material for the elastic band would have been within purview of the skilled artisan.

With respect to claim 10, all the limitations were addressed above with respect to claims 16-18, except the pressure element having a length that is less than that of the narrow face of the board element, with it being noted that claim 10 **does not require** movement of the workpiece along its length. LaMers is not limited to a particular shaped workpiece and therefore is not limited to a particular size for the workpiece. Therefore, the skilled artisan would have appreciated it being obvious to apply the label of LaMers to a workpiece whose size is such that the length of the pressure element is less than that of a narrow face of the workpiece because it is well known and conventional for a label to only cover a portion of a surface.

Regarding claim 11, all the limitations were addressed above with respect to claims 10 and 16-18.

Regarding claim 12, LaMers is not limited to a particular shaped workpiece and therefore is not limited to a particular size for the workpiece. Therefore, the skilled artisan would have appreciated it being obvious to apply the label of LaMers to a workpiece whose size is such that the length of the pressure element is substantially less than that of a narrow face of the workpiece because it is well known and conventional for a label to only cover a portion of a surface.

With respect to claim 14, all the limitations were addressed above with respect to claims 16-18; it being noted that claim 14 requires moving **at least one** of the pressure element and the board element.

Regarding claim 15, LaMers is not limited to a particular shaped workpiece and therefore is not limited to a particular size for the workpiece. Therefore, the skilled artisan would have

Art Unit: 1733

appreciated it being obvious to apply the label of LaMers to a workpiece whose size is such that the length of the pressure element is substantially shorter than that of a narrow face of the workpiece because it is well known and conventional for a label to only cover a portion of a surface.

15. Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over LaMers, Hodgson and Treat as applied to claim 5 above, and further in view of Schut et al. (US 6376058, of record), as set forth in paragraph 17 of the previous action.

Regarding claim 6, one reading the reference as a whole would have appreciated that LaMers is not concerned with a particular adhesive. It is known in the art to attach labels to objects using a hot-melt adhesive as an alternative to a pressure sensitive adhesive, as taught by Schut (column 14, lines 9-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a hot-melt adhesive as an alternative to a pressure-sensitive adhesive for the labels of LaMers because such is known in the art, as taught by Schut, wherein only the expected results would have been achieved.

16. Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over LaMers, Hodgson and Treat as applied to claim 5 above, and further in view of Paulk et al. (US 6529799, of record), as set forth in paragraph 18 of the previous action.

Regarding claim 7, the references are silent as to the board element comprising Applicant's claimed materials. It is known in the art to attach adhesive labels to boards wherein the board comprises such materials as chipboard, fiber board, or solid wood board, as taught by Paulk (column 4, lines 1-5; column 6, lines 1-5; column 7, lines 57-63).

Art Unit: 1733

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the label of LaMers to a board element comprising the materials claimed in the present invention because such is known in the art, as taught by Paulk, and this allows for identification of the board element based on the information printed on the label.

17. Claims 10-12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manusch as applied above and further in view of Paulk et al.

With respect to claims 10 and 14, if it is not taken the substrate 8 of Manusch is a board element, it would have been obvious to apply the film/label (= bandlike covering) to a substrate that is a board element because Manusch is clearly not concerned and/or limited to a particular substrate and it is known in the art to apply films/labels to board elements, as taught by Paulk (column 4, lines 1-5; column 6, lines 1-5; column 7, lines 57-63), where this allows for identification of the board element based on the information printed on the film/label.

18. Claims 5-9 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manusch as applied to claims 10-12 and 14-15 above.

With respect to claim 5, all the limitations were addressed above in paragraph 10 with respect to claims 10 and 14, except moving the board element along its length in relation to the pressure element while pressing the covering onto the narrow face of the board element. The skilled artisan reading the reference as a whole would have appreciated that the pressure element is hand-held and can be used to apply the covering to a variety of substrates big and small, including those that are not permanently fixed in place and could be moved and/or held by the user during application of the covering; therefore, it would have been obvious and well within the scope of the reference to move the board element along its length while holding the pressure

Art Unit: 1733

element stationary or to move both the board element and pressure element along the length of the board element, but in opposite directions, during the pressing step because only the expected results would have been achieved.

Regarding claim 6, selection of a particular adhesive would have been within purview of the skilled artisan depending on the materials of the covering and/or board element.

Regarding claim 7, selection of a particular material for the board element would have been within purview of the skilled artisan.

Regarding claims 8-9, Manusch teaches such (column 8, lines 40-42).

Regarding claim 16, all the limitations were addressed above with respect to claim 5; it being noted that claim 16 is **broad**er because it does not limit the covering to a bandlike covering nor does it limit the workpiece to a board element.

Regarding claims 17-18, these limitations were addressed above with respect to claim 5.

19. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Manusch as applied to claim 16 above, and further in view of Paulk et al.

With respect to claim 18, if it is not taken the workpiece of Manusch is a board element, it would have been obvious to apply the film/label (= covering) to a substrate that is a board element because Manusch is clearly not concerned and/or limited to a particular substrate and it is known in the art to apply films/labels to board elements, as taught by Paulk (column 4, lines 1-5; column 6, lines 1-5; column 7, lines 57-63), where this allows for identification of the board element based on the information printed on the film/label.

Response to Arguments

20. Applicant's arguments filed 7/1/05 have been fully considered but they are not persuasive.

21. On p. 7 of the remarks, Applicant argues that LaMers does not teach the workpiece being moved relative to the pressure element (bellows) while the label is applied to the workpiece.

The examiner respectfully points out that Applicant is incorrect. One reading the reference as a whole would readily appreciate that part of what sets LaMers invention apart from the prior art is that the bellows is capable of applying the label to an article while the article is moved/conveyed past the bellows (last sentence of abstract; column 3, lines 60-63; column 10, lines 43-48).

Applicant tries to support his argument by reference to that stated in column 3, lines 60-63 of LaMers, which states that "...movement of the plunger is timed..." - The examiner points out that Applicant has drastically misinterpreted this portion of the specification because any skilled artisan reading the reference would readily appreciate that the 'timing' referred to therein has to do with making sure that movement of the plunger is commenced at a time such that a label will be applied to a workpiece as it passes by the bellows and not commenced too soon or too late so that the label misses the moving workpiece.

The examiner would further like to support her position that the reference teaches moving the workpiece along its length while the bellows applies a label thereto by directing Applicant's attention to column 10, lines 43-48 where the reference states that the bellows is "extremely fast (about 2.6 milliseconds),...and can easily label products going by at high speed (24" per second) without damage."

Art Unit: 1733

22. On p. 8 of the remarks, Applicant argues that LaMers does not teach exerting uniform pressure while uniformly pressing the covering onto the surface because the bellows face contains a recess having three slits cut into the recess to form an opening, where the three slits form flaps which can readily bend inwardly but not outwardly.

The examiner would like to point out that the three flaps are formed from the same elastically deformable material as the rest of the face of the bellows. While vacuum is being applied to the bellows to hold the label against the surface thereof the flaps are bent inwardly, but when pressured air is applied inside the bellows to transfer the label from the bellows to the workpiece the flaps press against one another to close the opening (column 4, line 62 – column 5, line 4). Therefore, while the flaps press against one another to close the opening, there is no longer an opening in the face of the bellows and therefore uniform pressure is applied to the workpiece (Figures 7 and 27). As for the reference stating that the flaps cannot bend outwardly – the examiner points out that the reference is talking about the flaps being distended such that they would extend beyond the face of the bellows - this is obviously not what is taking place when the flaps press against each other to close the opening.

23. On p. 9-11 of the remarks, Applicant argues that Mathis does not teach moving the embossing die relative to the board element along the length of the board element uniformly pressing the covering onto the board element because although the reference teaches progressive engagement of the die with the workpiece to bring the die and workpiece into contact with each other, the pressing which takes place after this progressive engagement step does not involve movement of either the die or workpiece.

Art Unit: 1733

The examiner would first like to point out that Applicant has mistakenly interpreted the examiner's rejection and equated some other step of Mathis, which takes place after the progressive engagement step of Mathis, to be that which the examiner has equated to Applicant's claimed pressing step. The examiner would like to invite Applicant to reread the rejection set forth in paragraph 7 above where it was clearly set forth that the pressing step of Mathis is the progressive engagement step, which clearly involves uniformly pressing the covering onto the board element!!

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JESSICA ROSSI
PRIMARY EXAMINER**

